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OFFICE OF PETITIONS

In re Application of :
Seebacher et al. :
Application No. 08/135,059 : DECISION ON PETITION
Filed: 12 October, 1993 :
Atty Docket No. 233808419 :

This is a decision on the renewed petition filed on 17 September, 2004, under 37 CFR 1.137(b)¹, to revive the above-identified application.

The petition is **GRANTED**.

The instant application became abandoned for failure to submit a proper reply to the Notice of Appeal filed on 2 October, 1996. On 2 April, 1997, petitioner filed a four (4) month extension of time and a first submission under 37 CFR 1.129(a). However, the

¹Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

37 CFR 1.129(a) submission was not a proper reply because the rule states that applicants may only file such a submission after final rejection if the application has been pending for at least two (2) years as of 8 June, 1995, taking into account any reference made in the application to any earlier filed application under 35 U.S.C. § 120, 121, and 365(c). Notice of Abandonment was mailed on 29 May, 1998.

Petitioners state, *inter alia*, that "[t]he entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional."

The record does not necessitate a finding that the delay between 2 May, 1997, and 17 September, 2004, was not unintentional.

Rather, the Patent and Trademark Office is relying on petitioners' duty of candor and good faith and accepting the statement that the entire delay in filing the required reply and until the filing of the petition was unintentional.²

Since this application is revived for purposes of continuity only with continuing Application No. 10/943,637, filed on 17 September, 2004, and since continuity has been established by this decision reviving the application, the application is again abandoned in favor of the above-referenced continuing application.

Under the circumstances of this case, the requirement for a terminal disclaimer under 37 CFR 1.137(c) is waived, sua sponte. The \$110.00 fee paid will be refunded. Therefore, the Terminal Disclaimer filed on 17 September, 2004, has not been accepted and will not be entered, but will remain in the application file.

As the submissions under 37 CFR 1.129(a) filed on 2 April, 1997, and 2 March, 1998, were improper, the fees paid with those submissions will be credited to counsel's deposit account, No. 04-0100, as authorized in the fee transmittal sheet accompanying the present petition.

This application is being referred to Technology Center Art Unit 3622 for further processing.

²See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.

A handwritten signature in cursive script, appearing to read "D Wood".

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions